

**REMARKS**

Claims 1-17 and 81-82 are currently pending. Of these claims: claims 3-4, 6-13 and 17 are original; claims 5, 14-16 and 81-82 were previously presented; claims 18-80 were previously withdrawn; claims 1 and 2 are currently amended; and, no claims are currently cancelled. In view of the following remarks, the Applicant respectfully requests reconsideration and withdrawal of the rejections and forwarding of the application on to issuance.

**The §101 Rejections**

The Patent Office rejected all claims as being directed to non-statutory subject matter, and suggested that they be directed to a “computer implemented” method. The Applicant has made this change to Claims 1 and 2.

**The §112 Rejections**

The Patent Office rejected Claims 1 and 2 over ambiguity involving the phrases “select” and “upon selection”. The Applicant has removed these phrases.

**The §103 Rejections**

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office’s rejections. However, before discussing the substance of the Office’s rejections, a section entitled “The §103 Standard” is provided and will be used in addressing the Office’s rejections.

**The §103 Standard**

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. MPEP § 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

1 ordinary skill in the art, to modify the reference or to combine reference teachings.  
2 *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d  
3 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable  
4 expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375  
5 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined)  
6 must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180  
7 USPQ 580 (CCPA 1974).

8 Hence, when patentability turns on the question of obviousness, the search  
9 for and analysis of the prior art includes evidence relevant to the finding of  
10 whether there is a teaching, motivation, or suggestion to select and combine or  
11 modify the references relied on as evidence of obviousness. The need for  
12 specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371,  
13 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to  
14 the reason the skilled artisan, with no knowledge of the claimed invention, would  
15 have selected these components for combination in the manner claimed").

### 16 **§103 Rejections due to Redpath and LeBlond**

17 **Claims 1, 3-8, 11, 12 and 14-17** were rejected under §103 as being  
18 unpatentable over U.S. Patent No. 5,630,126, hereinafter "Redpath," in view of  
19 *PC Magazine*, hereinafter "LeBlond." In response, the Applicant respectfully  
20 traverses the rejection.

### 21 **Traversal of the §103 Rejections to Claims 1, 3-8, 11, 12 and 14-17**

22 **Claim 1** has been amended to more particularly point out what is meant by  
23 "interpreting user entry based upon the type of content of the free floating field."  
24 In particular, the Applicant determines the type of the content already in the free-  
25

1 floating field, and then interprets the user's entered data in light of this  
2 determination. Accordingly, the Applicant's disclosure of "Smart Selection" (top  
3 of page 30 and other locations in the Applicant's specification) facilitates editing  
4 documents comprising a plurality of different types of content.

6 **Claim 1** recites a computer-implemented method comprising:

- 7 • presenting a free floating field in line with text in a document, the  
free floating field presenting content derived from a source;
- 8 • **interpreting user entry based upon a determination of a type of  
the content already in the free floating field;** and
- 9 • upon modification of the source, automatically updating the content  
in the free floating field.

11 With respect to the Redpath reference:

12 The Redpath reference *fails to teach or suggest* interpreting user entry  
13 based upon a determination of a type of the content already in a field. Instead,  
14 Redpath teaches that an input string itself may be evaluated for content type, and  
15 its meaning based upon that evaluation.

16 As noted by the Patent Office, the Redpath reference teaches that user input  
17 may include numeric and non-numeric strings (Redpath, column 6, lines 15—20).

18 More precisely, Redpath teaches:

19  
20 The evaluating operation 200 accepts user input in the form of either  
21 numeric or non-numeric strings, and either evaluates a formula contained  
within a first math part or assigns the value given to the math part.

22  
23 Thus, a string is accepted, apparently as input to the math part, wherein the  
24 string can be a numeric string or a non-numeric string. Redpath teaches that the  
25

1 math part evaluates a formula, if that is what the string contained, or assigns a  
2 value, if that is what the string contained.

3 Thus, Redpath does not interpret input based on *a determination of the*  
4 *content already in* the math part. Instead, Redpath appears to evaluate the input  
5 string based on the type of content contained within the input string. If the input  
6 string is a numeric string, then a value is assigned. If the input string is a formula  
7 (text) string, then the formula is evaluated in the math part. Therefore, Redpath  
8 interprets user entry based upon examination of the data entered, not based upon *a*  
9 *determination of the type of the content already in the free-floating field*.

10 The Patent Office points to Redpath at column 6, lines 15—18, and  
11 suggests that the Redpath system evaluates a formula or assigns a value based on  
12 type of content in a field. The Applicant respectfully disagrees.

13 The cited passage teaches that the Redpath system will accept input in the  
14 form of a string. It appears to imply, but does not explicitly state, that the string  
15 will be evaluated for evidence of containing a numeric value or a formula.  
16 Redpath also appears to imply that, if the input is a formula, then the formula is  
17 evaluated in the math part, and that, if the input is numeric, then the value is  
18 assigned to the math part.

19 Redpath does not disclose interpreting user entry based upon a  
20 determination of a type of content already in the field (math part). That is,  
21 Redpath looks at the input itself, and makes a determination as to how to evaluate  
22 the input. Redpath does not determine the type of content already in a field (math  
23 part), and then interpret user entry based on the determination.  
24  
25

1           Therefore, the Redpath system and Claim 1 have a different structure and  
2 method of operation. Accordingly, the Applicant respectfully requests that the  
3 Patent Office remove the rejection to Claim 1.

4           With respect to the LeBlond reference:

5           The LeBlond reference fails to teach or suggest interpreting user entry  
6 based upon a determination of a type of the *content already in a field*. Instead,  
7 LeBlond teaches, “status indicators are linked to a key or command that you have  
8 used to put the system in a specific state.” Once in a specific mode or status, input  
9 (e.g. keystrokes) is interpreted in view of the mode or status. For example, see the  
10 discussion in LeBlond at page 10 on the interpretation of the “end” key, wherein  
11 end mode or status results arrow keys moving to the end of continuous blocks.

12           Thus, LeBlond does not interpret user entry based upon a determination of  
13 the type of the content *already in the free-floating field*. Instead, LeBlond  
14 interprets user entry *based upon the current mode or status* (as indicated by the  
15 mode and status indicators).

16           The Patent Office points to pages 9—11 of LeBlond, wherein LeBlond  
17 discusses “mode and status indicators.” However, as LeBlond clearly points out,  
18 the current status or mode is “linked to a key or command that you have used to  
19 put the system in a specific state” (LeBlond, page 10). Thus, LeBlond interprets  
20 user entry based upon the status or mode, and allows the user to enter different  
21 states or modes by keystrokes (e.g. function keys). Accordingly, LeBlond does  
22 not interpret user entry based upon “a determination of the type of content already  
23 in” a field.  
24  
25

1 Accordingly, Redpath and LeBlond both *do not determine the content*  
2 *already in a field* as a guide in interpreting user entry. Redpath looks at the type  
3 of the user entry itself, and decides to evaluate a formula or assign a value  
4 (Redpath, column 6, lines 15—18). LeBlond responds to keystrokes that put the  
5 system into a mode, and then interprets input in light of the mode (LeBlond, pages  
6 9—11). Neither reference looks at the content *already in a field* to decide how to  
7 interpret incoming user data.

8 In view of the above discussion, the Applicant respectfully requests that the  
9 Patent Office remove the rejection to Claim 1.

10 **Claims 3-8 and 11-12** depend from Claim 1 and are allowable due to their  
11 dependence from an allowable base claim. These claims are also allowable for  
12 their own recited features that, in combination with those recited in Claim 1, are  
13 neither disclosed nor suggested in references of record, either singly or in  
14 combination with one another.

15  
16 **Claim 14** recites the method of claim 1, additionally comprising:

- 17 • wherein the free floating field and the source are in a nested  
18 relationship

19 The Redpath reference does not disclose nested relationships. In particular,  
20 Redpath discloses no math part wherein the contents of that math part include a  
21 ‘nested’ math part. That is, ‘nesting,’ in the context of the Redpath reference,  
22 would involve one math part within another math part. In contrast, simple data  
23 within a math part are not ‘nested’ within the math part.

24 The Patent Office suggests that the contents of the math part (i.e. the data  
25 contained within the math part) are the source, and that a nested relationship

1 therefore exists. (However, the Patent Office also suggested that Redpath and  
2 LeBlond do not disclose nesting. See top of page 12 of the Office Action mailed  
3 09/26/2005.)

4 The Patent Office's current position does not make sense in the context of  
5 Claim 1, which recites, "upon modification of the source, automatically updating  
6 the content in the free floating field." That is, the source and the content of the  
7 free-floating field are *different*, since a change in one requires automatic updating  
8 of the other. Thus, Redpath does not disclose a nested relationship.

9 Accordingly, because Redpath does not disclose the concept of 'nesting,'  
10 the Applicant respectfully requests that the rejection of Claim 14 be removed.

11  
12 **Claim 15** recites, wherein the determining of claim 1 comprises:

- 13 • evaluating whether the type of content is a formula or non-text data;
- 14 • if the type of content is a formula or non-text data, interpreting the  
15 user entry as applicable to spreadsheet functions; and
- 16 • if the type of content is not a formula or non-text data, **interpreting  
17 the user entry as applicable to word processing functions.**

18 The Redpath reference does not disclose word processing functions within  
19 the math parts of the document. Instead, the math parts appear to be limited to  
20 formulas and numbers. Word processing functionality is not included within the  
21 math parts.

22 In the rejection of Claim 15, the Patent Office cited column 6, lines 15-18  
23 of Redpath as disclosing the elements of all three paragraphs of Claim 15.

24 The cited passage in Redpath is as follows:

25 "The evaluating operation 200 accepts user input in the form of  
either numeric or non-numeric strings, and either evaluates a formula

1 contained within a first math part or assigns the value given to the math  
2 part."

3 The Applicant respectfully traverses the rejection.

4 The Applicant notes that the passage does not disclose a method by which  
5 user entry is interpreted according to word processing functions. For example, the  
6 math parts disclosed by Redpath include only numeric values, such as 9.5% and  
7 \$5,000. Word processing functionality is not provided for by Redpath *within the*  
8 *math parts*. In contrast, the Applicant discloses and claims word processing  
9 functionality within free-floating fields. Accordingly, the Applicant respectfully  
10 requests that the rejection to Claim 15 be withdrawn.

11 **Claims 16 and 17** depend from Claim 1 and are allowable as depending  
12 from an allowable base claim. These claims are also allowable for their own  
13 recited features that, in combination with those recited in Claim 1, are neither  
14 disclosed nor suggested in references of record, either singly or in combination  
15 with one another.

16 **§103 Rejections due to Redpath, LeBlond and Acklen**

17 **Claims 2, 81 and 82** stand rejected under 35 U.S.C. §103(a) as being  
18 obvious over Redpath and LeBlond in view of "Using Corel Wordperfect 9,"  
19 hereinafter "Acklen."

20 **Traversal of the §103 Rejections to Claims 2, 81 and 82**

21 **Claim 2** includes all of the restrictions of Claim 1 and is allowable for the  
22 same reasons, which are incorporated by reference herein.

23 **Claims 81 and 82** depend from Claim 1 and are allowable as depending  
24 from an allowable base claim. These claims are also allowable for their own  
25 recited features that, in combination with those recited in Claim 1, are neither



disclosed nor suggested in references of record, either singly or in combination with one another.

**§103 Rejections due to Redpath, LeBlond and Curbow**

**Claim 13** stands rejected under 35 U.S.C. §103(a) as being obvious over Redpath and LeBlond in view U.S. Patent No. 5,669,005, hereinafter "Curbow."

**The Curbow Reference**

The Curbow reference discloses a system for embedding and incorporating contents to a document. The document can include a "part," which is the fundamental building block. Each part includes content and a manipulator for that content. The manipulator can be any type of editor or viewer, such as a word processor. The word processor can be used to edit the part, even when embedded within a non-text document, such as a spreadsheet.

**Traversal of the §103 Rejections of Claim 13**

**Claim 13** recites, the method of claim 1 additionally comprising:

- modifying a format of the text and automatically applying the format modification to the free floating field.

The Curbow reference discloses documents having 'parts' of different types, such as text-based parts and spreadsheet type documents. Curbow discloses how the user is able to edit the parts, even when embedded within another document.

The Patent Office cites Curbow, at column 2, line 66 to column 3, line 9, and suggests that Curbow discloses modifying text within a document and having those modifications automatically apply to a free floating field.

1        However, what Curbow discloses in the cited passage is that a tool, such as  
2 a word processor, would be available to the user to edit the contents of any part,  
3 even if embedded within another document. Curbow does not disclose,  
4 “modifying a format of the text and automatically applying the format  
5 modification to the free floating field.”

6        At col. 3, lines 43-48, Curbow discusses adding material, and automatically  
7 changing the format of the content. However, this is not the same as “modifying a  
8 format of the text and automatically applying the format modification to the free  
9 floating field.” The former involves adding new material, while the latter involves  
10 modifying existing material. Also, the former involves combining material, while  
11 the latter involves two groups of material that remain distinct (although the format  
12 from one is applied to the other).

13        Therefore, Curbow fails to teach the recited claim. Accordingly, the  
14 Applicant respectfully requests that the rejection of claim 13 be removed.

15        **§103 Rejections due to Redpath, LeBlond and Microsoft**

16        **Claims 9 and 10** stand rejected under 35 U.S.C. §103(a) as being  
17 unpatentable over Redpath in view of “Microsoft Visual Basic 5.0 Programmer’s  
18 Guide, 1997, pgs. 578—579, Redmond, Washington, 98052-6399” hereinafter  
19 “Microsoft.”

20        **The Microsoft Reference**

21        The Microsoft reference discloses how a picture box can be sized to fit a  
22 picture to be displayed.

23        **Traversal of the §103 Rejections of Claims 9 and 10**

24        **Claim 9** recites the method of claim 8, further comprising:

- 25        • resizing the formula edit box as the user enters the formula.

1       **Claim 10** recites the method of claim 8, further comprising:

- 2           • extending the formula edit box horizontally and subsequently  
3           vertically as the user enters the formula.

4       The Microsoft reference discloses how a picture box can be sized to fit a  
5       picture to be displayed. However, sizing a box to fit a picture fails to address and  
6       resolve issues and complexities related to sizing a box as a user enters a formula,  
7       particularly wherein the formula has an unknown length. For example, a picture  
8       has a size, which when discovered, can be matched with a picture box of  
9       appropriate size. In contrast, a text box may receive a user-entered formula of  
10      unknown and/or changing size; accordingly, the recited features “resizing” and  
11      “extending” provide functionality not seen in the references that address problems  
12      associated with receiving a formula of unknown size.

13      In particular, the Microsoft reference fails to disclose how a box can be  
14      resized *as a user enters a formula*, or how a box can be extended horizontally and  
15      vertically *as a user enters a formula*. Entry of text into a box is different from  
16      entry of a picture, since any given picture is fixed in size. In contrast, entry of a  
17      formula is something that changes dynamically as each keystroke enters an  
18      additional character. Thus, a formula edit box that resizes as the user enters a  
19      formula is differently adapted than an edit box that is sized to fit a picture to be  
20      displayed.

21      Accordingly, the Microsoft reference does not disclose the elements recited  
22      by the claims, and the Applicant respectfully requests that the rejections be  
23      removed and Claims 9 and 10 be allowed to issue.

Conclusion

The Applicant submits that all of the claims are in condition for allowance and respectfully requests that a Notice of Allowability be issued. If the Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests that the undersigned attorney be contacted for scheduling an interview.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified over the telephone, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully Submitted,

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